REMARKS

Claims 54-85 are pending. Claims 54, 56, 58, 64, 70, 72, 74 and 80 are rejected. Claims 55, 57, 59-63, 65-69, 71, 73, 75-79 and 81-85 are objected to. The rejection of claims 58-69 and 74-5-85 under 35 U.S.C. § 112, first paragraph was withdrawn following the response mailed April 18, 2005.

Claims 54, 56, 58, and 64, and claims 70, 72, 74 and 80 respectively are rejected under new grounds for being allegedly anticipated by separately cited references under 35 U.S.C. § 102(b). Claims 55, 57, 59-63, 65-69, 71, 73, 75-79 and 81-85 are objected to for depending from rejected claims.

Claims 54 and 70 are currently amended to further limit claimed subject matter to an isolated nucleic acid linked to a promoter to permit expression of a rat or human Progression Suppressed Gene-13 protein respectively. These amendments do not constitute new matter and are supported by the specification.

For reasons set forth below, it is respectfully requested that the rejections be withdrawn and that the claims be deemed allowable.

1. The Claims Are Not Anticipated

First, claims 54, 56, 58, and 64 are rejected under 35 U.S.C. § 102(b), as being allegedly anticipated by GenBank accession number AA891723, previously cited against the claims in the Official Action mailed January 30, 2003.

Second, claims 70, 72, 74 and 80 are rejected under 35 U.S.C. § 102(b), as being allegedly anticipated by GenBank accession number N39717.

According to the Examiner:

> [T]he Office reinstates the rejection because the isolated nucleic acid disclosed in GenBank accession number AA891725 comprises a nucleic acid encoding SEQ ID NO:2 as claimed in the instant claim 54. GenBank accession number AA891725 also discloses that the nucleic acid is in

> a pT7T3Pac . . . polylinker region flanked by T7 and T3 promoter. Therefore it is the Office position that the nucleic acid insert is operatively linked to a promoter. In addition, GenBank accession number . . . is from clone RKIAG02.
>
> and further that
>
> [T]he term "clone" inherently include a host cell, i.e. an organism that contains the vector containing the nucleic acid of interest.

None of the rejected claims are anticipated by the cited art. The Examiner is requested to reconsider the rejections for reasons set forth below. Claims directed to the rat and human sequence are addressed separately below since the reference cited against each is different.

In response to the first element of the rejection of the rat sequence, Applicants note that claim 54 is directed to an isolated nucleic acid encoding a Progression Suppressed Gene-13 protein as set forth in SEQ ID NO:2. As in a prior response filed July 30, 2003, to a rejection similar to herein, Applicants asserted that GenBank accession number AA891725 (henceforth AA891725) does not disclose a protein encoding Progression Suppressed Gene-13 protein. It merely described an undefined EST (Expressed Sequence Tag) sequence derived from rat kidney mRNA with partial homology to the nucleic acid encoding SEQ ID NO:2. This sequence when reversed and complemented contained the complete open reading frame for Progression Suppressed Gene-13 protein. However even if persons skilled in the art conceptually translated the sequence disclosed in AA891725, they would find it encoded several possible protein sequences or open reading frames. In addition, since AA891725 is in a reverse orientation, even less guidance is provided as to its capacity to encode a protein set forth in SEQ ID NO:2.

AA891725 does not provide information about a Progression Suppressed Gene-13 protein as set forth in SEQ ID NO:2, and therefore does not anticipate the invention set forth in claim 54 since the standard of strict identity required for anticipation is not met.

The second element whereby AA891725 allegedly anticipates the instant invention is that it discloses a nucleic acid operatively linked to a promoter and furthermore this nucleic acid is inherently included in a host cell, i.e. clone RKIAG02. The rejected claims are directed to a nucleic acid encoding a protein set forth in SEQ ID NO:2, operably linked to a promoter (claim 54); host cells prepared by introducing into the cell, isolated nucleic acid or vector of claims 54-57; such that the host cell expresses the rat Progression Suppressed Gene-13 protein (claims 58-69). As described above, AA891725 does not anticipate claim 54 nor claims dependent thereon. Thus the promoter and host cell of AA891725 will not anticipate the present invention since it is not directed to a nucleic acid encoding a protein set forth in SEQ ID NO:2, even if a sequence linked to a promoter or present in a host cell is described. Applicants note that the T7 and T3 promoters and clone RKIAG02 pertain to bacteriophage promoters and bacterial host cells respectively. Such expression systems may be effective in expressing a RNA sequence from a DNA placed between the two promoters but would not express the protein set forth in SEQ ID NO:2.

In the interest of advancing prosecution, Applicants have amended claim 54 to read "operably linked to a promoter to permit expression of a rat Progression Suppressed Gene-13 protein." Following this amendment and in

light of the above statements, claim 54 and claims dependent thereon are not anticipated by the cited reference and the rejection should be withdrawn.

Rejected claims 70, 72, 74 and 80 are directed to expressing a human Progression Elevated Gene-3 protein and to cells expressing the isolated nucleic acid or vector which encode said protein. Genbank accession number N39717 (henceforth N39717) is alleged to anticipate these claims because of sequence homology to SEQ ID NO:3 and also because N39717 is operatively linked to T7 and T3 promoters and is present in a host cell.

As in the response to rejection of claim 54 and its dependent claims, Applicants assert that the cited reference does not anticipate claims directed to the human Progression Elevated Gene-13 protein (SEQ ID NO:4) or related nucleic acid, vectors and host cells. The claims are not anticipated because the standard of strict identity required for a rejection based on anticipation is not met. The undefined EST sequence N39717 even when linked to T7 and T3 promoters and present in a bacterial DH10B clone does not disclose a nucleic acid encoding Progression Suppressed Gene-13 protein or host cell expressing such protein. Applicants have amended claim 70 to advance prosecution. The isolated nucleic acid of claim 70, encoding a human Progression Suppressed Gene-13, operably linked to a promoter is amended to specify "expression of Progression Suppressed Gene-13 protein."

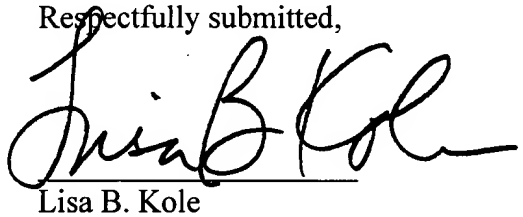
Following the above remarks and amendment, Applicants assert that claims 70, 72, 74 and 80 and claims dependent thereon are not anticipated by the cited reference and the rejection should be withdrawn.

2. **Conclusion**

For all the foregoing reasons, Applicants request that the claims be deemed allowable. A Notice of Allowance is therefore respectfully requested.

This response is timely file within the three month period set for filing a response. Applicants therefore believe that no additional fee is due in connection with this response. However, should an additional fee be required, the Commissioner is hereby authorized to charge any such fee to Deposit Account No. 02-4377.

Respectfully submitted,



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